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10/579,845	05/17/2006	Walter Rosenbaum	2004P19118	5727
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LERNER GREENBERG STEMER LLP			EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/579,845

Applicant(s)

ROSENBAUM, WALTER

Examiner

GEORGE CHEN

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-040)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. DETAILED ACTION

2. This communication is a final action in response to amendment filed on 04/25/2011.

Claims 1-5, 7-11, 13, 14 are pending.

3. Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

6. Claims 1 and 7 comprises multiple limitation with if statement. However, the claims do not cover the scenario when the condition of the if statement is not met. Therefore, the claim is indefinite because it is unknown what would happen when the condition is not met; and when applying broadest reasonable interpretation, it appears that if the condition is not met, the steps covered by the if statement is not needed.

7. Examiner recommend a more positive recitation of the condition. For instance, if said scanned TAG ID specific to the post is expired can be amended as determining that scanned TAG ID specific to the post is expired. For another example, Applicant may choose to cover the scenario that the condition in the if statement is not met.

8. Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan Jr. et al. (hereinafter Ryan, US 20050065897 A1) in view of Lopez (US 20020029202 A1), further in view of Lubart (US 20050192913 A1)

11. As per claim 1, Ryan discloses a method of forwarding post, comprising the steps of:

- ✓ scanning an address face of the post for a TAG ID specific to the post (see at least Ryan, 0021, system monitors the tracking codes, such as package identification codes used as delivery confirmation codes)
- ✓ consulting a database for records related to the scanned TAG ID specific to the post while using the scanned TAG ID specific to the post, wherein the records contain information indicating if said scanned TAG ID is expired (see at least Ryan, 0022, the system continues to periodically interrogate the tracking code database for a tracking code lifetime period.)

Ryan does not explicitly disclose

- ✓ if the TAG ID specific to the post is expired
- ✓ automatically determining if an addressee of the post maintains a forwarding service account, and
- ✓ if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address in the forwarding service account

Ryan however, discloses charging customer if expired TAG ID reenters mail stream (see at least Lopez, Ryan, If the tracking code is observed during the lifetime period, a surcharge is imposed).

Lopez teaches determining a forwarding service account of addressee (see at least Lopez, 0035, some of the mailpieces to be processed are to be forwarded to a receiver forwarding address).

One of ordinary skill in the art would have recognized that applying the known technique of Lopez to Ryan would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lopez to the teaching of Ryan would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such fee collection. Further, applying the step of checking forwarding address for mails that are reentering mail stream of Lopez to monitoring mail identification code of Ryan, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient mail processing.

Lubart teaches if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address in the forwarding service account (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least

0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service).

One of ordinary skill in the art would have recognized that applying the known technique of Lubart to Ryan would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lubart to the teaching of Ryan would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such fee collection. Further, applying fee collection for additional service to Ryan, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generation (Lubart 0078).

12. As per claim 7, claim 7 contains limitation substantially similar to that of claim 1 and is herein rejected under similar rationale as set forth above.

13. As per claim 14, Ryan discloses the method according to 1 wherein the post is an item of mail (see at least Ryan, 0021, monitoring package identification codes as mail pieces are processed in the mail stream).

14. **Claims 2-4, 8-10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Lopez further in view of Lubart, even further in view of Nielsen (US 6405243 B1).**

15. As per claim 2, Ryan discloses the method according to claim 1, but does not explicitly disclose further comprising the step of automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account.

Nielsen does not explicitly teach offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account because having the forwarding service would not take into effect if the account is under funded, as if the user has never registered in the first place.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Ryan would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Ryan would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Ryan would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more revenue generated from customers.

16. As per claim 3, Ryan discloses the method according to claim 2, but does not explicitly disclose comprising the step of not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account

Lopez teaches not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account (see at least Lopez, 0047, if delivery is again unsuccessful, the mailpiece is returned to RTS (return-to-sender) processing).

One of ordinary skill in the art would have recognized that applying the known technique of Lopez to Ryan would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Lopez to the teaching of Ryan would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such fee collection. Further, applying the step of checking returning to sender of Lopez to monitoring mail identification code of Ryan, would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient mail processing.

17. As per claim 4, Ryan discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying the post.

Lopez teaches not forwarding nor returning mail (see at least Lopez, 0035, some mailpieces that cannot be delivered but are not worth the cost of return postages, the sender will want notification).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from identifying mails that are not worth the cost of returning to destroy the mail pieces because the mail piece is not needed for either the sender or the mail processing facility and disposing unneeded items is as obvious as throwing away trash.

18. As per claim 8, claim 8 contains limitation substantially similar to that of claim 2 and is herein rejected under similar rationale as set forth above.

19. As per claim 9, claim 9 contains limitation substantially similar to that of claim 3 and is herein rejected under similar rationale as set forth above.

20. As per claim 10, claim 10 contains limitation substantially similar to that of claim 4 and is herein rejected under similar rationale as set forth above.

21. As per claim 13, Ryan further discloses the apparatus according to 10 wherein the post is an item of mail (see at least Ryan, 0021, monitoring package identification codes as mail pieces are processed in the mail stream)

22. Claims 5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Lopez further in view of Lubart, even further in view of Nielsen, even more further in view of Webb (US 20040020978 A1).

23. As per claim 5, Ryan discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a pre-selected time delay prior to destruction of said post.

Webb teaches having a pre-selected time delay prior to destruction of said post (see at least Webb, 0003-0004, when the mail box door is closed, the process is started. The process run for a prescribed time sufficient to destroy any biological organisms. The process can start after an adjustable delay).

One of ordinary skill in the art would have recognized that applying the known technique of Webb to Ryan would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Webb to the teaching of Ryan would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having a pre-selected time delay prior to destruction of said post to Ryan would have been recognized by one of ordinary skill in the art as resulting in an improved system that would consider the possibility of mistakes.

24. As per claim 11, claim 11 contains limitation substantially similar to that of claim 5 and is herein rejected under similar rationale as set forth above.

25. Response to Argument

26. Regarding Applicant's argument directed to 103 rejection

27. **Applicant's arguments, have been fully considered but are moot in view of the new ground(s) of rejection.**

28. Applicant's arguments are moot in view of Ryan and Lopez.

29. Conclusion

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **GEORGE CHEN** whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G.C./

/IGOR BORISSOV/
Primary Examiner, Art Unit 3628